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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/741,536	12/19/2003	Kent D. Vincent	200314650-1	5132

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EXAMINER

EGWIM, KELECHI CHIDI

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/741,536

Applicant(s)

VINCENT ET AL.

Examiner

Dr. Kelechi C. Egwim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-65 is/are pending in the application.
- 4a) Of the above claim(s) 1-35, 40, 42, 44 and 48-65 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-39, 41, 43 and 45-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 042005.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's affirmation of the election of species a) in Genus A and species a) in species B of Group IV, claims 36-39, 41, 43 and 45-47 in the reply filed on 06/13/2005 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).

### ***Claim Rejections - 35 USC § 102/103***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 36-39, 41, 43, 45 and 46 are rejected under 35 U.S.C. 102(a) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Ohta

et al. (US 2002/0198287); claims 36-39 and 43 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Handa et al. (JP 62283174) or Patel et al. (USPN 5,981,651); claims 36-39, 43 and 47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Johnson et al. (EP 1108758); and claims 36-39, 41, 43 and 45-47 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, 35 U.S.C. 103(a) as being unpatentable over Nichols et al. (EP 869 160).

In ¶ 11-17, Ohta et al. teach a latex-containing ink-jet ink comprising a) an aqueous liquid vehicle, b) a pigment colorant dissolved or dispersed in the liquid vehicle, and c) dispersed surface sulfonated acidic emulsion (latex) particulates.

In the abstract, Handa et al. teach a latex-containing ink-jet ink comprising a) an aqueous liquid vehicle, b) a pigment colorant dissolved or dispersed in the liquid vehicle, and c) dispersed acidic emulsion (latex) particulates.

In col. 6, lines 45-56, Patel et al. teach a latex-containing ink-jet ink comprising a) an aqueous liquid vehicle, b) a pigment colorant dissolved or dispersed in the liquid vehicle, and c) dispersed acidic emulsion latex particulates.

In ¶ 8, 14 and 24, Johnson et al. teach a latex-containing ink-jet ink comprising a) an aqueous liquid vehicle, b) a pigment colorant dissolved or dispersed in the liquid vehicle, and c) dispersed acidic emulsion resin latex particulates.

In page 4, lines 4-14 and page 5, lines 37-42, Nichols et al. teach a latex-containing ink-jet ink comprising a) an aqueous liquid vehicle, b) a pigment colorant

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dissolved or dispersed in the liquid vehicle, and c) dispersed acidic emulsion resin latex particulates.

While the prior art may not expressly teach the product to be prepared by the process recited in the claims, the products of the prior art are the same as, or an obvious variant of, the presently claimed product absent evidence that the particular process of making results in a materially different product. Even though product-by-process claims are limited and defined by the process, determination of patentability is based on the product itself. The patentability of the product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. See *In re Marosi*, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113.

5. The following prior art are made of record, but not relied upon, are considered pertinent to applicant's disclosure: US006239193B1, US006541590B1, US005936008A, US006031019A and US2003/0176532A1.

6. Due to persuasive arguments filed 06/13/2005 by applicant, the previous rejections of record have been overcome and are hereby withdrawn.

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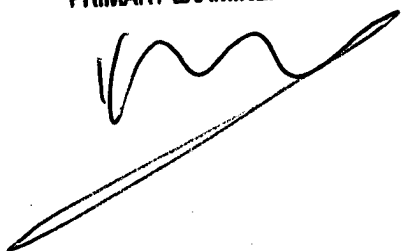
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dr. Kelechi C. Egwim whose telephone number is (571) 272-1099. The examiner can normally be reached on M-T (7:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**KELECHI C. EGWIM PH.D.**  
**PRIMARY EXAMINER**

KCE

A handwritten signature in black ink, consisting of a series of loops and a long, sweeping underline.